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10/081,945	02/22/2002	Brian D. Bailie	TAC 9764.1	4482
321	7590	10/08/2004	EXAMINER	
SENNIGER POWERS LEAVITT AND ROEDEL ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			HIRL, JOSEPH P	
			ART UNIT	PAPER NUMBER
			2121	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/081,945

Applicant(s)

BAILIE, BRIAN D.

Examiner

Joseph P. Hirl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to an AMENDMENT entered July 27, 2004 for the patent application 10/081,945 filed on February 22, 2002.
2. The First Office Action of May 3, 2004 is fully incorporated into this Final Office Action by reference.

### ***Status of Claims***

3. Claims 1, 2, 4, 7-9, 11, 14-16, 18 and 21 have been amended. Claims 3, 10, and 17 have been cancelled. Claims 1, 2, 4-9, 11-16, and 18-21 are pending.

### ***Specification***

4. The amendment filed July 27, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: All changes to the specification as identified on pages 2-16 of the subject amendment with the following exception. Such exception generally refers to "Computer Program Listing Appendix on CD-ROM and such change is acceptable as listed below.

Page 1 of specification, lines 3-17

Page 4 of specification, lines 9-13

Page 9 of specification, only the reference to "Computer Program Listing  
Appendix on CD-ROM"

Page 12 of specification, lines 8-13

Page 12 of specification, lines 16-26

Page 12, of specification, lines 27-28

Page 13 of specification, lines 3-4

Page 13 of specification, lines 21-26

Page 13 of specification, line 30

Page 13 of specification, line 37

Page 14 of specification, line 1

Page 14 of specification, line 6

Page 14 of specification, lines 7-8

Page 14 of specification, lines 11-12

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 7, 8, 14, 15 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term manufacturing is new to the specification and introduces a concept different from that of mere creating. Further, operator, parameter and related software relationships has further introduced new concepts (specification @ p 2, lines 13-26).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4-9, 11-16, and 18-21 rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al (IEEE 1063-6730/94, referred to as **Chen**).

Examiner's Note: the following rejection is based on original disclosure ...  
without new mater.

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**Claims 1, 15**

Chen anticipates a knowledge base of a plurality of parameters relating to embroidery designs (**Chen**, p 693, c 2, l 11-18); a rules base of rules interrelating two or more of the parameters (**Chen**, p 693, c 2, l 11-18); selection software for designating a defined parameter from the plurality of parameters (**Chen**, p 695, c 1, l 6-17); analysis software for applying the rules to the defined parameter and for generating one or more recommended parameters as a function of the defined parameter (**Chen**, p 695, c 1, l 6-17); and display software for providing a display corresponding to the defined parameter and the one or more recommended parameters (**Chen**, p 693, c 2, l 3-26; p 695, Fig. 2; Examiner's Note (EN): Chen address computer implementation through the prior art to include the abstract. ).

**Claims 2, 9, 16**

Chen anticipates the parameter is selected from the following categories of parameters: hoping technique, stabilization technique, topping material, backing material, thread weight, thread type, needle type, needle size, embroidery density, project/fabric type, fabric thickness, fabric density, fabric stretch and design size (**Chen**, p 695, c 1, l 6-17).

**Claims 4, 11, 18**

Chen anticipates the selected parameter is project/fabric type wherein the selection software designates two or more defined parameters and wherein the defined parameters comprise fabric thickness and fabric stretch (**Chen**, p 693, c 1, l 3-26; EN: editing provides the opportunity to adjust parameters such as fabric type which include

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fabric thickness and stretch characteristics following from the type of rules identified by Chen on page 694, c 2 and further implemented in Fig. 2 on p 695).

**Claims 5, 12, 13, 19**

Chen anticipates the operator may modify the defined parameter (**Chen**, p 693, c 1, l 18-22; EN: editing will modify the defined parameter).

**Claims 6, 20**

Chen anticipates the operator may modify the defined parameter and wherein the analysis software applies the rules to the modified defined parameter (**Chen**, p 693, c 1, l 3-26) .

**Claims 7, 14, 21**

Chen anticipates the knowledge base includes comments, photographs or multimedia presentations which are a function of the selected parameter, the defined parameter, and/or one or more of the recommended parameters and wherein the display software displays the provided comments, photographs or multimedia presentations (**Chen**, p 694, c 1, l 14-32; p 693, c 1, l 3-26; a graphic representation or photograph is scanned into the knowledge base and the computer-aided design displays the graphic (photo converted) results).

**Claim 8**

Chen anticipates designating a defined parameter relating to the embroidery design (**Chen**, p 694, c 1, l 40-41); applying the rules to the defined parameter (**Chen**, p 695, c 1, l 6-17); generating one or more recommended parameters as a function of the application of the rules to the defined parameter (**Chen**, p 695, c 1, l 6-17); and

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displaying the defined parameter and the one or more recommended parameters

(Chen, p 695, c 1, l 6-17).

### ***Response to Arguments***

9. The objection to the specification related to the computer programming code under 37 CFR 1.96(c) is withdrawn.
10. The rejection to claims 1-14 under 35 USC 101 is withdrawn.
11. The rejection to claims 1-14 under 35 USC 112, first paragraph, is withdrawn.
12. Applicant's arguments filed on July 27, 2004 related to Claims 1, 2, 4-9, 11-16, and 18-21 have been fully considered but are not persuasive.

In reference to Applicant's argument:

Applicant, on the other hand, enables the operator of an embroidery machine to generate parameters to manufacture "a quality embroidered fabric from the embroidery design." (Spec. p. 4, l. 24-25). The manufacturing parameters disclosed by the Applicant are not stitch data but include needle type, thread weight and/or stabilizers. (Spec. p. 6, l. 31-33). These manufacturing parameters relate to the manufacture of a particular embroidered fabric (i.e. embroidery design on silk) and not stitch data.

Examiner's response:

The term "manufacturing" is new to the disclosure and is objected to above. The specificity of embroidery is not part of claim 1.

In reference to Applicant's argument:

Claims 1 and 15 stand rejected under 35 U.S.C. §102 (b) as being anticipated by Chen. Applicant disagrees and submits that Chen does not disclose a selection software, analysis software or display software as recited by claims 1 and 15.



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Examiner's response:

Chen's abstract and p 693, c 2, para 3.2 applies.

In reference to Applicant's argument:

Regarding the selection software, amended claims 1 and 15 recite that the selection software is "responsive to the operator for permitting the operator to select a parameter". Thus, the operator controls the selected parameters. For example, the operator may accept defaults or modify parameters as desired. (Spec., p. 13, 1. 30-32). Additionally, amended claims 1 and 15 recite that the selection software is "for defining an additional parameter from the plurality of parameters where the defined parameter is a function of the operator selected parameter".

Examiner's response:

The selection software responsive to the operator for permitting the operator to select a parameter is new matter that was added to the specification on p 2, lines 13-16 and is objected to above as new matter in the specification. The concept is rejected above as not enabled by the original specification.

In reference to Applicant's argument:

The passage from Chen cited by the Examiner as selection software discloses how the inference engine of NeedlePaint works. The passage states "all tape-shaped regions ... are found by inference and the midline ... are generated automatically by the midline algorithm". (Chen, p. 695, c. 1, 1. 14-17). Additionally, the inference engine is part of the stitch organizing module (Chen, p. 693, c. 1, 1. 16-17) and the program performs the organizing module automatically (Chen, p. 692, c. 2, 1. 27-30), thus, without operator intervention. Applicant submits that the Examiner's conclusory finding of "selection software" is without basis. In other words, the module and algorithm described in Chen do not constitute selection software that is "responsive to the operator for permitting the operator to select a parameter" and do not constitute software that is "for defining an additional defined parameter ...where the defined parameter is a function of the selected parameter".

Examiner's response:

Para 15. applies. Responsive to the operator for permitting the operator to select a parameter is new matter that was added to the specification on p 2, lines 13-16 and is

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objected to above as new matter in the specification. The concept is rejected above as not enabled by the original specification.

In reference to Applicant's argument:

Regarding the analysis software, amended claims 1 and 15 recite that the analysis software applies "the rules to the defined and selected parameters for generating one or more recommended manufacturing parameters from the plurality of parameters, where the recommended manufacturing parameter is a function of the defined parameter", so that the rules are applied to at least one of the parameters selected by the operator (using the selection software) to generate at least one recommended manufacturing parameter. (Spec., p. 11, 1. 29-34).

Examiner's response:

This is new matter and the above objection /rejection applies.

In reference to Applicant's argument:

Chen does not yield manufacturing parameters and provides only stitch data. Contrary to the claim, the Examiner cited the passage from Chen that discloses the definition of a tape-shaped region and how the mid-line of such a region may be calculated. (Chen, p. 695, c. 1, 1. 6-8). The passage continues to explain that the mid-line of such a region "needs to be found so that stitches can be organized correctly". (Chen, p. 695, c. 1, 1. 89). The passage concludes by explaining that the "mid-line of each tape-shaped region is generated automatically by the midline algorithm". (Chen, p. 695, c. 1, 1. 15-17). Thus, this passage explains how the mid-line of a taped-shaped region is computed using an algorithm to organize the stitch data. Accordingly, this reference does not anticipate the analysis software, which generates recommended manufacturing parameters from operator defined and selected parameters using the rules in a rules base as recited in the claims. In addition, there is no teaching relating to a manufacturing parameter that is a function of the defined parameter.

Examiner's response:

Responsive to the operator for permitting the operator to select a parameter and the concept of manufacturing is new matter and the above objection /rejection applies.

In reference to Applicant's argument:

Regarding the display software, claims 1 and 15, as amended, recite that the display software provides "a display corresponding to the selected and defined parameters and corresponding to the one or more recommended manufacturing parameters". Furthermore, according to claims 1 and 15, the analysis software generates the recommended manufacturing parameters used by the display software so that the

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display software will display parameter information after the selected and defined parameters have been analyzed and the recommended manufacturing parameters have been generated. (Spec., Fig. 2).

But, the passage cited by the Examiner from Chen as display software refers to a generic "friendly user interface" and a figure, Figure 2. Chen does not refer to Figure 2 in the cited passage and contrary to 37 C. F. R. 1.104 (c)(2)1, the Examiner has failed to offer any explanation of how that passage and the Figure 2 relate to one another. However, on page 695 Chen refers to Figure 2, disclosing "all tape-shaped regions are found by inference and the midline of each tape-shaped region are generated automatically by the Midline Algorithm[1][2] as shown in Figure 2(b)". (Chen, p. 6595, c. 1, 1. 14-17). Thus, contrary to the Examiner's conclusion, the cited Figure 2 is not generated and displayed by the software; it is a diagram used by Chen in his paper to illustrate the mid-line found by the Mid-Line Algorithm.

Conclusively, Chen discloses that the output of his process is not displayed at all. On page 693, Chen unambiguously states that the stitch data is the result of the program and that result is stored in a specific medium so it may control an embroidery machine. (Chen, p. 693, c. 2, 1. 41-44). Therefore, because the stitch data generated by NeedlePaint is stored in a specific medium and not displayed, Chen cannot anticipate the display software recited by claims 1 and 15 that displays information corresponding to the selected, defined and manufacturing parameters

Examiner's response:

The manufacturing concept is new matter and the above objection /rejection applies. As is known by one of ordinary skill in the art and stated in the abstract by Chen, computer software is being used and therefore computer monitors are involved. Further, Chen @ p 692, c 2, l 7-8 cites the use of a mouse. Further, to one of ordinary skill in the art, typically one does not use a mouse without a monitor. Hence Chen has graphic displays or monitors and an out is the natural conclusion of the use of a mouse ... it illustrates just what the operator has just done. Figure 2 is a computer drawn picture developed from a printer or a monitor. Notwithstanding the applicants views, Chen has a graphic output. A mouse axiomatically has a monitor.

In reference to Applicant's argument:

Furthermore, regarding claims 2, 9, and 16, the Examiner argues that Chen anticipates that the parameter selected is from the following categories of parameters: hooping technique, stabilization technique, topping material, backing material, thread weight, thread type, needle type, needle size, embroidery density, project/fabric type, fabric thickness, fabric density, fabric stretch and design size.

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Applicant disagrees and submits that Chen does not anticipate selecting parameters from these categories.

Examiner's response:

First Office Action applies. Mere denial by applicant represents an insufficient argument.

In reference to Applicant's argument:

The Examiner's repeated reference to the cited passage on page 695 is without merit or reason. As explained in detail above, Chen is disclosing the: definition of a tape-shaped region and explaining how the mid-line algorithm finds the mid-line of such a region to aid in generating stitch data. (Chen, p. 695, c. 1, 1. 6-17). This process relates to the shape of a sub-region of the design. (Chen, p. 694, c. 2, 1. 45-49). On the other hand, Applicant's categories of parameters relate to the physical manufacture of the embroidered fabric and not to the shape of the embroidery design.

Examiner's response:

First Office Action applies. The manufacturing concept is new matter and is rejected.

In reference to Applicant's argument:

Furthermore, regarding claims 5, 12, 13, and 19 the Examiner argues that Chen anticipates that the embroidery machine operator may modify the defined parameter. Examiner argues that the editing disclosed in Chen provides the opportunity to modify the defined parameter. Applicant disagrees and submits that Chen does not anticipate the modification of a defined parameter by the embroidery machine operator.

Examiner's response:

First Office Action applies. Mere denial that Chen anticipates the modification of a defined parameter by applicant represents an insufficient argument. Certainly Chen @ Fig. 2 identifies the modification of a design parameter.

In reference to Applicant's argument:

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While a casual reading of the passage indicates that NeedlePaint results may be edited, the detailed disclosure provided by Chen unambiguously teaches that algorithms and mathematical operators accomplish the editing. The stitch optimizing module is used to transform and edit stitch data. (Chen, p. 693, c. 1, 1. 23-35). On page 695, Chen explains that in this module that "many algorithms and operators have been designed and implemented" and lists examples such as "mirroring, scaling, rotating, and reversing". (Chen, p. 695, c. 1, 1. 2224). Thus, Chen teaches that these mathematical operators and algorithms perform the editing. Most significantly, on page 692, Chen unequivocally states "automatic processing, organizing and optimizing are made possible by utilizing image processing, computer-aided design, and artificial intelligence". (Chen, p. 692, c. 1, 1. 9-12). Consequently, the Chen editing process works "automatically" utilizing "artificial intelligence" and not through the modifications input by an embroidery machine operator.

Examiner's response:

Para 15 applies. Chen @ p 692, c 1, l 7-8 identifies the operator interface. To one of ordinary skill in the art, a mouse is a very simply to modify an input parameter...and then modify it again as an input for another design which is equivalent to modification of the initial design.

In reference to Applicant's argument:

Furthermore, regarding claims 6 and 20 the Examiner again argues that Chen anticipates the embroidery machine operator may modify the defined parameter. Further, the Examiner argues that the rules are applied to the modified parameter. Applicant disagrees and submits that Chen does not anticipate the modification of a defined parameter by the operator.

Examiner's response:

Para 15 applies. The above comments apply.

In reference to Applicant's argument:

As noted above, all processing in NeedlePaint is automatic. Therefore, the editing done in the contour processing module or the stitch organizing module is done automatically, without the intervention of an embroidery machine operator. (Chen, p. 693, c. 1, 1. 28-30). Therefore, if Chen cannot anticipate the editing of a parameter by an embroidery machine operator, it cannot anticipate the application of rules to such a parameter.

Examiner's response:

Para 15 applies. Chen @ p 692, c 1, l 7-8 identifies the operator interface. To one of ordinary skill in the art, a mouse is a very simply to modify an input parameter ...

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and then modify it again as an input for another design which is equivalent to modification of the initial design.

In reference to Applicant's argument:

Furthermore, regarding claims 7, 14 and 21 the Examiner argues that the knowledge base includes comments, photographs or multimedia presentations which are the function of the selected parameter, the defined parameter, and one or more of the recommended parameters and wherein the display software displays the provided comments, photographs or multimedia presentations. Applicant disagrees and submits that Chen does not anticipate that the knowledge base contains comments, photographs or multimedia presentations and that the software displays these comments, photographs or multimedia presentations.

First, an image may be scanned into NeedlePaint, but it is input to a data structure. (Chen, p. 693, c. 2, l. 27-33). Chen discloses "four knowledge bases: the stitch pattern base, the organizing base, the bean pattern base and wave pattern base, all of which contain popular organizing knowledge and patterns." (Chen, p. 694, c. 2, l. 14-18). Thus, the knowledge base does not contain the input image, comments, photographs or multimedia presentations.

Second, Chen does not disclose that the input image is displayed. on page 692, Chen outlines the NeedlePaint process: (1) operating staff inputs the designs; (2) NeedlePaint processes, organizes and optimizes to generate stitch data automatically; and (3) NeedlePaint transforms stitch data into specific codes corresponding to specific embroidery machine. (Chen, p. 692, c. 2, l. 25-33). Additionally, Chen discloses that "stitch data is the running result" and this result is stored "in specific medium"; thus, the result is not displayed. (Chen, p. 963, c. 2, l. 41-44). Therefore, Chen does not anticipate display software that displays photographs or multimedia presentations. Nor does Chen anticipate that comments, photographs or multimedia presentation are in the knowledge base.

Examiner's response:

Again, claims 7, 14 and 21 contain new matter represented by the manufacturing concept which is objected/rejected above. Knowledge bases are a form of data bases and each knowledge base that is resident in a computer has a data base representation. Para 15 applies and the data base qualifies. Further, to one of ordinary skill in the art, if one is using a mouse (Chen @ p 692, c 2, l 7-8), one has to have a monitor to provide the graphic feedback or the system simply won't work. Now, it is known that a mouse functions well with a monitor and hence, Chen has disclosed that the input image is displayed.

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In reference to Applicant's argument:

Claim 8 stands rejected under 35 U.S.C. §102 (b) as being anticipated by Chen. Applicant disagrees and submits Chen does not anticipate defining, applying and displaying as recited by claim 8.

Examiner's response:

The above discussion applies.

In reference to Applicant's argument:

With regard to the definition of a parameter, the Examiner cited a passage from Chen that explains how the image processing module performs its automatic steps relating to shapes and patterns. (Chen, p. 694, c. 1, 1. 17-18). The "improved Laplacian operator" disclosed by Chen is a mathematical operator, not an embroidery machine operator. Contrary to 37 C.F.R. 1.104(c)(2), the Examiner has failed to offer any explanation of how the image processing steps described by Chen anticipates an embroidery machine operator "defining selected and defined parameters relating to the embroidery design where the defined parameter is a function of the selected parameter".

Examiner's response:

The Laplacian Operator does edge detection ... edge detection represents parameters which is obvious to one of ordinary skill in the art ... Para 15 applies. Again, claim 8 represent new matter in the form of the manufacturing concept and related parameters.

In reference to Applicant's argument:

With regard to applying the rules, the Examiner cited the passage that gives a definition for the term mid-line. As explained above, this passage is explanatory of a term of art, and is not a parameter defined by the embroidery machine operator.

Examiner's response:

Para 15 applies. Such is a parameter.

In reference to Applicant's argument:

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With regard to generating one or more recommended manufacturing parameters, the Examiner is once again citing the passage describing the mid-line algorithm. As explained above, this is an algorithm operating on a tape-shaped region, not a rule in a rules base. Thus, Chen does not anticipate "generating one or more recommended manufacturing parameters as a function of the application of the rules to the defined parameter."

Examiner's response:

Again this is new matter that was objected/rejected above.

In reference to Applicant's argument:

With regard to displaying the parameters, the Examiner is citing the passage describing the mid-line algorithm. As explained above, this is an algorithm for computing the mid-line of a tape-shaped region. Figure 2 is not displayed to an embroidery machine operator; it is merely illustrative of a mid-line found by the algorithm. Contrary to 37 C.F.R. 1.104(c)(2), the Examiner has failed to offer any explanation of how Chen's disclosure of this algorithm anticipates "displaying the selected and defined parameters and the one or more recommended manufacturing parameters."

Examiner's response:

Again this is new matter that was objected/rejected above.

### ***Examination Considerations***

13. The claims and only the claims form the metes and bounds of the invention.

"Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Examiner will reference prior art using terminology familiar to one of ordinary skill in the



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art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

14. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

15. Examiner's Opinion: Paras 13. and 14. apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Claims 1, 2, 4-9, 11-16, and 18-21 are rejected.

***Correspondence Information***

19. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (703) 308-3179.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,  
Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of

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"Proposed" or "Draft" for the desk of the Examiner).

Note: During the last two weeks of October 2004, Art Unit 2121 will move to Carlyle, Randolph Building, 5<sup>th</sup> floor and my phone and fax number will change to: 571-272-3685 and 571-273-3685, respectively. Similarly, Anthony Knight's phone and fax numbers will change to: 571-272-3687 and 571-273-3687.



Joseph P. Hirl

October 4, 2004



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